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09/525,491	03/15/2000	Mary Thomasma Tackbary	9203/031c3	9815

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EXAMINER

POND, ROBERT M

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 05/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/525,491

Applicant(s)

TACKBARY ET AL.

Examiner

Robert M. Pond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 45-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 45-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

The Applicant filed a Request for Reconsideration. Claims 45-80 are pending in this non-final office action.

Response to Arguments

The Applicant's argument objecting to the non-statutory double patenting rejection is not persuasive. This examiner maintains the position that instant Claims 45, 57, and 69 are not patentably distinct from US 5,960,412 and US 6,092,054. The Applicant argues that the recitation of the delivery of social expression cards to a plurality of recipients is nowhere articulated in the claims of these cited patents. Instant Claims 45, 57, and 69 are broader in some respect than the referred patented claims because certain structures and/or functions are omitted from the instant claims, except for the issue of "initiating delivery to a plurality of recipients." This examiner addresses this issue in the body of the Double Patenting rejection.

Applicant's arguments with respect to Claims 45-80 have been considered but are moot in view of the new ground(s) of rejection. The applicant argues that the system and method of Cannon et al. is based on a single transaction which do not provide the customer with the capability to store data relating to: multiple recipients, recipient addresses, recipient occasions, order history, or order status.

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Cannon et al. remains as the base reference and maintains an order history at least up to the point of order completion dictated by a shipping date (please see Fig. 19 (70, 71); Fig. 20b (79) and in effect supports on-going management at least to this point, allows a customer to send cards to multiple recipients, stores recipient addresses and recipient occasion information. Furthermore, Cannon et al. teach flag order status to note order progress. Instant Claims 45-80 do not claim order history in any claim element.

New art was cited that solves the pertinent problem of a pervasive technology used in office or home environments: eliminating the need to repeat transmissions of a fax document to each individual on a recipient distribution list by initiating delivery of information to a plurality of recipients using a one-time process. Gordon et al. teaches the practicality and advantage of the one-time process initiating delivery to a plurality of recipients. Furthermore, it is this examiner's contention that since a service employing the system and method of Cannon et al. is promoting ordering convenience, it would realize that forcing the customer into repeated single card order transactions is inherently inconvenient to customers desiring to purchase and send a greeting card to more than one recipient (e.g. employee staff, more than one relative, more than one friend), and therefore there is risk that this category of customers may take their business elsewhere (e.g. traditional card shop). One of ordinary skill in the art of conducting business, owing a business, being responsible to shareholders, or being responsible for sales would feel the impact to lost business from

competitors aware of the pertinent problem of repeated single transactions, and therefore would be motivated to make changes to the system and method to capture more sales revenue by allowing customers to build an order to send cards to multiple recipients.

Double Patenting

The non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper time-wise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

- 1. Claims 45, 57, and 69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 51, 68, and 72 of U.S. Patent No. 5,960,412, and Claims 1, 21, 31, 41, 45, and 49 of U.S. Patent No. 6,092,054 (please see the table below for clarification).**

Patent Number	Instant Claim 45	Instant Claim 57	Instant Claim 69
US 5,960,412 (‘412)	1	51, 68, and 72	51, 68, and 72
US 6,092,054 (‘054)	1, 41	21, 31, 45, and 49	21, 31, 45, and 49

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are broadened by the omission of certain structure and/or functions present in the patented claims except for the recitation “initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.”

Regarding the broadening aspects of instant Claims 45, 57, and 69, In re Karlson, 136 USPQ 184 (CCPA 1963) on patentability cites: Omission of element and its function in combination is obvious expedient if remaining elements perform same functions as before; and further cites In re Attwood, 45 CCPA 824, 828, 253 F.2d 234, 117 USPQ 184, 187, as pertinent: the Appellant has done no more than to select a plurality of individual features from the prior art and incorporate them into a unitary structure without materially altering the structure or function of each individual feature and without producing any new or unexpected result.

It is this examiner’s contention that since the structure, method, and functionality of the prior patented art provide a user-selected choice to a) initiate

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delivery of a social expression card to a recipient or b) to initiate delivery of social expression cards to a plurality of recipients, the instant application claiming delivery of social expression cards to a plurality of recipients does not produce any new or unexpected result.

Examples of obviousness-type double patenting are cited below to clarify this examiner's position. The Applicant's instant claims are interlaced and underlined with the corresponding claims of the prior patent art.

Example A

Claim 41 of U.S. Patent No. 6,092,054 recites (Instant Claim 1 underlined):

A method for on-going management, selection, and delivery of social expression cards, the method comprising the steps of:

storing a plurality of recipient data records for said user, each of said user's recipient data records containing data which defines a selected recipient;

storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;

storing a plurality of recipient occasion data records for said user, each of said user's recipient occasion data records containing data which defines a selected occasion for a selected recipient;

storing a plurality of social expression card data records, each of said social expression card data records containing data which defines a selected social expression card;

linking said recipient data, said recipient occasion data, and said social expression card data, thereby forming linked data to facilitate the on-going management, selection, and delivery of a social expression card to a selected recipient; and

linking the recipient data with social expression card data, containing data which defines at least one social expression card, thereby forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

providing a user interface to permit a user to access at least a portion of said data stored in said at least one database to permit the user to manage, select, and facilitate the delivery of a social expression card to said selected recipient.

Providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

Example B

Claim 1 of U.S. Patent No. 5,960,412 recites (Instant Claim 1 underlined):

A method for on-going management, selection, and delivery of social expression cards, the method comprising the steps of:

- (a) storing data in one or more databases, the data including recipient data and social expression card data;

storing data in at least one database, the data including a plurality of recipient data records for said customer, each of said customer's recipient data records containing data which defines a recipient;

- (b) linking the recipient data with the social expression card data thereby forming linked data to facilitate the on-going management, selection, and delivery of the social expression cards;

linking the recipient data with social expression card data, containing data which defines at least one social expression card, thereby forming linked data to facilitate the on-going management, selection, and delivery of social expression cards; and

- (c) providing a user interface to permit a user to access the data to permit the user to manage, select, and facilitate the delivery of the social expression cards;

Providing a customer interface to permit said customer to access the data to permit said customer to initiate the delivery of social expression cards by said order fulfillment center to a plurality of said recipients.

- (d) receiving and accepting a social expression card order from the user, the social expression card order indicating a user-selected method of delivering the social expression card; and

- (e) delivering the social expression card to a recipient according to the user-selected method of delivery.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 2. Claims 45, 50-53, 57, 62-65, 69, and 74-77 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, in view of Gordon et al., patent number 4,994,926.**

Cannon et al. teach a system, method, means, databases, and programs for viewing, ordering, and printing social expression cards for customers who remotely order greeting cards over a computer network. Cannon et al. teach printing cards at the user location or at remote locations, a database defining the layout of selected cards by occasion (e.g. Birthday), displaying graphical images, personalizing messages, transacting multiple card orders, recipient information, envelop printing, and delivery modes. Cannon et al. teach a an order information database, multiple modes of delivery (e.g. mail or delivered as noted in prior art), order information storage and retrieval, and unique order identifiers to retrieve orders (see at least abstract; Fig. 1 (15, 19); Fig. 3 (40, 50); 3a (36); Fig. 18 (52, 54, 66, 67, 68); col. 1, line 15 through col. 5, line 39). Cannon et al. teach storing order information in at least one database, the data in the order information database including recipient data records for a customer, and each recipient data

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records containing data that defines a recipient, and logically linking order information with card image, personalized messages, receiver and sender data, and order status data (see at least Fig. 19 (70, 71); col. 17, lines 3-8; lines 22-25; col. 18, lines 29-31). Cannon et al. teach linking the recipient data with social expression card data containing data which defines at least one social expression card, and forming linked data (see at least Fig. 19 (71, 72, 73); col. 18, lines 29-31). Cannon et al. further teach the following:

- Providing a customer interface to access databases and image files stored in a central data storage unit which may be accessed at a card display/order site facility and a card printing facility (see at least Fig. 18 (65, 66); col. 4, lines 56-59),
- Assigning each customer order with a unique order code and the order code being stored in the order information database and retrieved by the card printing facility for processing (see at least Fig. 19 (74); col. 4, lines 6-8; col. 18, line 59),
- Receiving an order initiated by a customer transmitting the order to a card printing site (see at least col. 17, lines 22-25;),
- Printing and shipping cards ordered by a customer or multiple customers, with order information stored in an order information database (see at least Fig. 19 (70, 71); Fig. 20b (79, 80)),

- Updating the order information to reflect the date the orders was processed and shipped (see at least Fig. 19 (85, 86); col. 19, lines 63-65), and
- Noting a known problem of card purchasers not remembering what card designs they have previously sent someone and being concerned about sending duplicates of cards previously sent (see col. 3, lines 50-55).

Cannon et al. teach all the above as noted under the 103(a) rejection and teach a) linking recipient data with greeting card data, b) the customer accessing the system to initiate delivery of a greeting card by a fulfillment center to a recipient, c) storing data in at least one database the information containing recipient data for said customer, and d) a plurality of recipient greeting card orders being placed into a order information database for daily processing (see at least Fig. 19 (70, 71); Fig. 20(b) (79, 80); col. 18, lines 34-36, 42-45; col. 19, lines 17-22), but are unclear as to whether the plurality of recipient data in the order information database belongs to the same sender. Gordon et al. teach a pertinent problem of providing a more practical means of initiating delivery of information to a plurality of recipients. Gordon et al. teach providing a practical means for fax machine users to automatically fax documents to multiple destinations, and further teach this as an advantage since it only ties up a broadcast user's machine for one outgoing transmission (see at least col. 3, lines

48-58). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. to provide a more practical means of initiating delivery to a plurality of recipients in a single process as taught by Gordon et al., in order to eliminate singly repeated start and stop processes associated with each separate greeting card order, and thereby attract more customers to the service due the additional convenience.

- 3. Claims 46-47, 58-59, and 70-71 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Gordon et al., patent number 4,994,926, as applied to Claims 45, 57, and 69, and in further view of Official Notice regarding express couriers.**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and further teach using mail or other purchaser delivery, but do not specifically disclose indicating to the customer multiple modes of delivery. This examiner takes the position that it is old and well-known that consumers and businesses use express couriers as alternative modes of mail or package delivery under circumstances where urgent delivery is required to meet a certain delivery date or to expedite delivery once past a certain delivery date. Therefore it would have been obvious to one of ordinary skill in the art at time of invention to modify the system, method, and means of Cannon et al. and Gordon et al. to provide the customer with multiple modes of delivery as taught by Official Notice,

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in order to better meet customer delivery requirements, and thereby attract repeat customers.

- 4. Claims 48-49, 60-61, and 72-73 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Gordon et al., patent number 4994,926, as applied to Claims 45, 57, and 69, and in further view of Hayes (PTO-892, Paper #7, Item: U).**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and further electronic shopping, ordering, and delivering social expression cards remotely or from a greeting card shop, but do not disclose selecting a gift to be included with the card. Hayes teaches Bullock & Jones combining a gift with a card selected through a mail-order catalog shopping service that offers various forms of electronic shopping to better service customers. Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Gordon et al. to provide a card and gift combination as taught by Hayes, in order to provide electronic shoppers a social occasion service capable of providing customers with a complete gift purchasing and card giving service emulating catalog services or in-store experiences, and thereby attracting more customers to the site.

- 5. Claims 54-56, 66-68, and 78-80 are rejected under 35 USC 103(a) as being unpatentable over Cannon et al., patent number 5,552,994, and Gordon et al., patent number 4994,926, as applied to Claims 45, 57, and 69, and in further view of Chartock (PTO-892, Paper #7, Item: V) and Mail List Management (a collection of articles cited in PTO-892, Paper #7, Items: W and X).**

Cannon et al. and Gordon et al. teach all the above as noted under the 103(a) rejection and teach a) desktop publishing systems (e.g. Pagemaker, QuarkXpress) allowing users to create custom publications, newsletters, brochures, b) using desktop publishing systems to create custom greeting cards, invitations, and business cards (see at least col. 2, lines 39-47), and c) using a mail management program (col. 18, line 25), but do not disclose the use of a mailing list of recipients or importing a mailing list. Chartock teaches desktop publishing and word processing being unified, and further teaches mail list management being integrated into desktop publishing-word processing products (see Item: V, page 1). Mail List Management teaches List&Mail, a mail list manager that allows users to create separate sub-lists with addresses drawn from the main file list (see Item: W, pages 8-9), and importing mail lists from external sources (e.g. Label Master, List Pro II, Mail-Track-II) (see at least Item: W, pages 7, 10, and 12). Mail List Management teaches desktop publishing systems to create newsletters and mailing lists comprising employees, potential customers, sales representatives, distributors, editors of appropriate business or

trade publications, and influential friends and colleagues (see Item: X, pages 1-2). Therefore it would have been obvious to one of ordinary skill in the art at time of the invention to modify the system and method of Cannon et al. and Gordon et al., to provide mail list application management features that support list creation, management, and list importation as taught by Chartock and Mail List Management, in order to provide more convenience to the customer in managing recipient lists, and thereby attract more customers to the site.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EDT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

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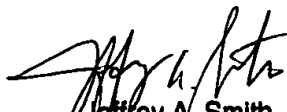
Washington D.C. 20231

or faxed to:

703-305-7687 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

RMP
May 5, 2003


Jeffrey A. Smith
Primary Examiner